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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,016	04/20/2001	Yukihiro Kiuchi	NE+99P237A	9360

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EXAMINER

SELLERS, ROBERT E

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,016

Applicant(s)

KIUCHI ET AL.

Examiner

Robert Sellers

Art Unit

1712

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-38 and 44-47 is/are pending in the application.
- 4a) Of the above claim(s) 26-33, 38, 44 and 47 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-37, 45 and 46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claims 26-33, 38, 44 and 47 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to nonelected species, there being no allowable generic or linking claim. The restriction and election of species requirement were timely traversed in the reply filed on July 29, 2003.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 34-37, 46 and 46 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed October 26, 2005 have been considered but are unpersuasive.

1. The specification on page 44, Table 2, Examples 5-8 containing only Epoxy resin 3 which is a tetraphenylethane epoxy resin according to page 22, lines 18-20 substantiates the sole presence of the tetraphenylethane epoxy resin described on page 17, lines 18-21, shown in Table 2 on page 44 and defined in withdrawn independent claim 26. Page 18, lines 3-5 generally describes a mixture of epoxy resins.

Art Unit: 1712

The only support for specific blends of a phenolbiphenylaralkyl epoxy resin and tetraphenylethane epoxy resin resides in Table 5 on page 44 wherein ratio of tetraphenylethane epoxy resin:phenolbiphenylaralkyl epoxy resin is 0.2:1, or 1:5.

2. The description of a general mixture of epoxy resins along with examples containing only a tetraphenylethane epoxy resin does not support the claimed broader ratio range of at least 1:5 which includes greater amounts of tetraphenylethane epoxy resin not contemplated.

Claims 34-37, 45 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese Patent No. 9-268219 in view of Japanese Patent Nos. 57-38814 and 58-150581.

The rejection is maintained for the reasons of record set forth in the previous Office actions. The arguments filed October 26, 2005 have been considered but are unpersuasive.

3. Japanese '219 (page 7, the last two lines) espouses the use of the composition as a closure ingredient for electronic ingredients, which is a rough translation for an encapsulant for an electronic device.

4. Japanese '219 on page 1, paragraph 3 discusses the inferior water resistance and mechanical strength of a polyfunctional epoxy resin such as a cresol novolak epoxy resin which is improved by its replacement with the claimed phenolbiphenylaralkyl epoxy resin (page 2, paragraph 5).

The reference is not averse to the inclusion of a polyfunctional epoxy resin as evidenced by page 6, paragraphs 33-34 wherein the incorporation of up to 30% by weight of other epoxy resins such as a novolak epoxy resin is suitable.

5. The motivation for employing the tetraphenylethane epoxy resin of Japanese '814 and '581 as the other epoxy resin of Japanese '219 in order to enhance the heat distortion temperature (Japanese '814) and mechanical properties (Japanese '581) is consistent with the objective of better mechanical strength desired by Japanese '219. According to MPEP § 2144, "Rationale Different from Applicant's is Permissible," "[t]he reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant." *In re Linter*, 173 USPQ 560, CCPA 1972; *In re Dillon*, 16 USPQ 2d 1897, Federal Circuit 1990.

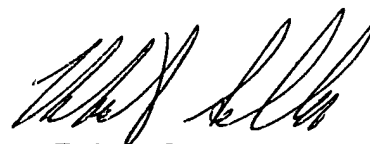
6. It is not necessary that the reason for the use of the tetraphenylethane epoxy resin of Japanese '814 and '581 as the other epoxy resin of Japanese '219 address the claimed objective of flame retardancy without a flame retardant or flame retardant auxiliary. There is no evidence of record that the closest prior art example of Japanese '219 (page 10, paragraph 57 employing phenolbiphenylalkyl epoxy resin (B) according to page 9, paragraph 52 and a novolak epoxy resin (D) as indicated on page 10, paragraph 55) does not exhibit flame retardancy. Neither the disclosure nor examples of Japanese '219 mention any flame retardant or flame retardant auxiliary.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712